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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/021,102

12/05/2001

Ronald C. Card

80398P488

8971

8791 7590 03/22/2007  
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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/22/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/021,102

Applicant(s)

CARD, RONALD C.

Examiner

DANIEL LASTRA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :02/26/2002;03/18/2002;07/03/2003;11/24/2003;03/15/2004;05/21/2004;06/04/2004;12/16/2004;07/27/2005;12/19/2005;02/26/2007.

### DETAILED ACTION

1. Claims 1-60 have been examined. Application 10/021,102 (SYSTEM AND METHOD TO PROVIDE FINANCIAL REWARDS AND OTHER INCENTIVES TO USERS OF PERSONAL TRANSACTION DEVICES) has a filing date 12/05/2001 and Claims Priority from Provisional Application 60254382 (12/07/2000).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14, 19-26, 31-38 and 43-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US 6,999,943).

Claims 1, 19, 31 and 43, Johnson teaches:

A method comprising:

processing a plurality of transactions between a personal transaction device and at least one vendor connected to said personal transaction device (see col 10, lines 60-65; col 25, lines 57-62; col 26, lines 23-27); and

determining vendor incentives for said at least one vendor (see col 12, lines 5-50) and user incentives for a user connected to said personal transaction device based on each transaction of said plurality of transactions (see col 9, lines 29-40).

Claims 2, 20, 32 and 44, Johnson teaches:

The method according to claim 1, wherein said processing further comprises:  
receiving each transaction of said plurality of transactions (see col 9, lines 30-40;  
col 18, lines 55-67); and  
storing a plurality of user characteristics related to said each transaction in a user  
profile within a user database (see col 18, lines 55-67).

Claims 3 and 45, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics  
further comprises purchasing preferences of said user (see col 18, lines 55-60).

Claims 4 and 46, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics  
further comprises financial information related to said user (see col 18, lines 65-67).

Claims 5 and 47, Johnson teaches:

The method according to claim 2, wherein said plurality of user characteristics  
further comprises a transaction history of said user (see col 18, lines 57-60).

Claims 6, 21, 33 and 48, Johnson teaches:

The method according to claim 1, further comprising:  
updating a vendor account within a user database with a predetermined incentive  
related to said each transaction of said plurality of transactions (see col 10, lines 55-60);  
and updating a user award account within said user database with a predetermined  
user incentive after said each transaction is processed (see col 9, lines 30-40; col 24,  
lines 60-67).

Claims 7 and 49, Johnson teaches:

The method according to claim 6, wherein said predetermined incentive is a fee paid subsequent to each use of said personal transaction device to complete said each transaction (see col 12, lines 1-50).

Claims 8 and 50, Johnson teaches:

The method according to claim 6, wherein said predetermined incentive is a rate charged for purchasing information related to said user and requested by said at least one vendor (see col 12, lines 1-50).

Claims 9 and 51, Johnson teaches:

The method according to claim 6, wherein said predetermined incentive is a rate charged for advertising (see col 27, lines 40-60).

Claims 10, 22, 34 and 52, Johnson teaches:

The method according to claim 1, further comprising: transmitting said vendor incentives to said at least one vendor, if a vendor account stored within a user database and containing said vendor incentives is equal to a predetermined vendor incentive value (see col 12, lines 1-50).

Claims 11, 23, 35 and 53, Johnson teaches:

The method according to claim 1, further comprising:  
notifying said user through said personal transaction device that said user incentives are available, if a user award account stored within a user database and containing said user incentives is equal to a predetermined user award value (see col 9, lines 30-40 "award points").

Claims 12, 24, 36 and 54, Johnson teaches:

The method according to claim 11, further comprising: retrieving a user profile from said user database; adapting said user incentives to said user profile; and transmitting said user incentives to said personal transaction device (see col 18, lines 45-67).

Claims 13, 25, 37 and 55, Johnson teaches:

The method according to claim 11, further comprising automatically transmitting said user incentives to said personal transaction device (see col 9, lines 30-45).

Claims 14, 26, 38 and 56, Johnson teaches:

The method according to claim 11, further comprising:  
transmitting a message to said personal transaction device describing said user incentives (see col 14, lines 40-45);  
receiving a reply message from said personal transaction device, said reply message containing a selection of a selected user incentive of said user incentives; and  
transmitting said selected user incentive to said personal transaction device (see col 14, lines 40-45).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 27-30, 39-42 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 6,999,943).



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Claims 15, 27, 39 and 57, Johnson does not expressly teach:

The method according to claim 14, wherein said message prompts said user to select said selected user incentive from an incentive list containing said user incentives. However, Official Notice is taken that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so.

Claims 16, 28, 40 and 58, Johnson does not expressly teach:

The method according to claim 14, wherein said message prompts said user to select or decline receipt of said user incentives. However, Official Notice is taken that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so.

Claims 17, 29, 41 and 59, Johnson does not expressly teach:

The method according to claim 1, further comprising:

transmitting an incentive list containing said user incentives to said personal transaction device; receiving a selection of a selected user incentive from said personal transaction device and transmitting said selected user incentive to said personal



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transaction device. However, Official Notice is taken that it is old and well known in the promotion art to allow users to select earned incentives from a list of incentives using a portable device. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson would allow users to select an incentive from a list of incentive using a portable device, as it is old and well known to do so.

Claims 18, 30, 42 and 60, Johnson does not expressly teach:

The method according to claim 1, further comprising:

notifying said at least one vendor that said user incentives are available, if a user award account stored within a user database and containing said user incentives is equal to a predetermined user award value. However, Official Notice is taken that it is old and well known in the promotion art to notify a vendor or a user of an available incentive when said user award account (*i.e.* points) reached a predetermined threshold in order that said user redeems an award. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Johnson would notify a user and a vendor when said user's award account balance reached a predetermined threshold amount in order that said user redeems an award.

### ***Conclusion***

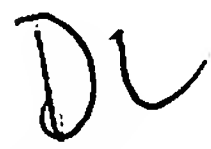
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

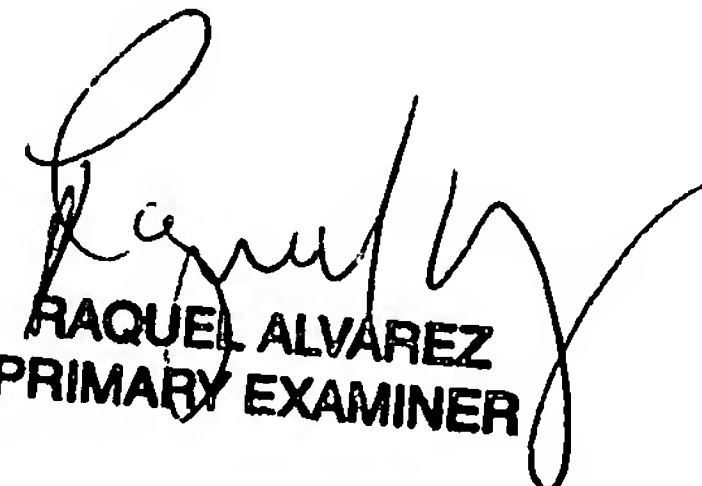
- Bednarek teaches a system for promoting commerce.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
March 12, 2007

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER